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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/566,818	01/27/2006	Miki Nishida	205700203927US0	9018
7278 7590 09/04/2009 DARBY & DARBY P.C. P.O. BOX 770 Church Street Station New York, NY 10008-0770			EXAMINER HUSON, MONICA ANNE	
			ART UNIT	PAPER NUMBER
			1791	
			MAIL DATE	DELIVERY MODE
			09/04/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/566,818

Applicant(s)

NISHIDA ET AL.

Examiner

MONICA A. HUSON

Art Unit

1791

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 May 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 2, 4, 5 and 11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 11 is/are allowed.
- 6) ☒ Claim(s) 1, 2, 4 and 5 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-856)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

This office action is in response to the Amendment filed 5 May 2009.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2, 4, and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Suzuki, in view of Shiraishi et al. (U.S. Patent 6,124,384).

Regarding Claim 1, Suzuki shows that it is known to have an injection molded article (Abstract), comprising a resin composition comprising a lactic acid based resin containing an L-lactic acid:D-lactic acid ratio of 100:0 to 97:3 (Column 4, lines 10-14), and a natural fiber (Column 4, lines 34-40), wherein the resin composition contains the lactic acid based resin and the natural fiber in a mass ratio of 99:1 to 70:30 (Column 4, lines 53-57). Suzuki does not show the contents of the natural fiber. Shiraishi shows that it is known to create an injection molding composition that contains lactic acid and a natural fiber that contains 40 mass% to 60 mass% of cellulose and 10 mass% to 30 mass% of lignin (Column 5, lines 58-61; Column 6, lines 40-55; Column 9, lines 22-25; note that bamboo and bagasse are known natural fibers that meet the claimed fiber composition). It would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to use Shiraishi's natural fiber as the fiber in Suzuki's molding process in order to make the article biodegradable (See Shiraishi, Column 2, lines 44-53). Suzuki does not show the particular physical properties that are claimed. However, Suzuki and Shiraishi teach all of the claimed ingredients, and thus, the claimed effects and physical properties would be implicitly achieved by using the claimed composition that is thus suggested by the prior art. If it is applicant's position

that this would not be the case, (1) evidence would need to be presented to support applicant's position, and (2) it would be the examiner's position that the application contains inadequate disclosure in that there is no teaching as to how to obtain the claimed properties and effects by using only the claimed composition.

Regarding Claim 2, Suzuki shows the article as claimed as discussed in the rejection of Claim 1 above, but he does not show the particular physical properties that are claimed. However, Suzuki and Shiraishi teach all of the claimed ingredients, and thus, the claimed effects and physical properties would be implicitly achieved by using the claimed composition. If it is applicant's position that this would not be the case, (1) evidence would need to be presented to support applicant's position, and (2) it would be the examiner's position that the application contains inadequate disclosure in that there is no teaching as to how to obtain the claimed properties and effects by using only the claimed composition.

Regarding Claims 4-5, Suzuki shows the article as claimed as discussed in the rejection of Claim 1 above, including an article made of lactic acid based resin and a natural fiber (Column 2, lines 18-20, 65-67; note that this is product by process claim which is not limited to the manipulation of the recited steps, only the structure implied by the steps (MPEP 2113)), meeting applicant's claim.

Response to Arguments

Applicant's arguments, see Remarks, filed 5 May 2009, with respect to claim 11 have been fully considered and are persuasive. The rejection of claim 11 has been withdrawn.

Applicant's arguments filed 5 May 2009 with respect to claims 1-2 and 4-5 have been fully considered but they are not persuasive.

Applicant contends that the claimed properties now incorporated into claim 1 would not implicitly be achieved with the combination's suggested composition. Applicant further contends that Table 1 of the instant specification proves that the composition of Suzuki alone does not have a deflection temperature under load of

133C. This is not persuasive because the examiner has not interpreted that the composition of Suzuki alone meets the claimed invention. Further, this is not persuasive because the prior art, *as combined*, suggests the claimed composition. Since the prior art, *as combined*, suggests all of the claimed ingredients, the claimed physical properties would implicitly be achieved by using the disclosed composition. As noted above, if it is applicant's position that this would not be the case, (1) evidence would need to be presented to support applicant's position, and (2) it would be the examiner's position that the application contains inadequate disclosure in that there is no teaching as to how to obtain the claimed properties and effects by using only the claimed composition.

Applicant contends there is no motivation to use Shiraishi's natural fibers in Suzuki's composition. This is not persuasive because Suzuki clearly teaches that inorganic and organic fibers are known choices of reinforcing fibers (Column 4, lines 34-40). Since Shiraishi's natural fibers are a specific organic fiber, it is submitted that there would be motivation to use a specific natural fiber in order to enhance biodegradability, as taught by Shiraishi.

Allowable Subject Matter

Claim 11 is allowed.

The following is an examiner's statement of reasons for allowance: The prior art of record neither teaches nor suggests the claimed method for producing an injection molded article. Attorney arguments filed 5 May 2009, especially page 5-6, have been considered and are persuasive as to the nature of the patentability of claim 11 relative to the prior art of record.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MONICA A. HUSON whose telephone number is (571)272-1198. The examiner can normally be reached on Monday-Friday 7:00am-4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Johnson can be reached on 571-272-1176. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Monica A Huson
Primary Examiner
Art Unit 1791

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